

PATENT  
2801-0165P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Russell M. HAGEN et al. Conf.: Unknown  
Appl. No.: 09/<sup>985</sup>~~986~~,679 Group: Unknown  
Filed: November 5, 2001 Examiner: UNKNOWN  
For: NOVEL MEDICAL USE FOR TACHYKININ ANTAGONISTS

#5  
Harmon  
4/29/02

INFORMATION DISCLOSURE STATEMENT  
(SUBMISSION AFTER FILING OF AN APPLICATION  
BUT BEFORE FINAL REJECTION OR NOTICE OF ALLOWANCE  
OR CONCURRENTLY WITH A RULE 53(d) CPA APPLICATION  
OR WITH A RULE 1.114 RCE APPLICATION)

Assistant Commissioner for Patents  
Washington, DC 20231

March 5, 2002

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-1449(s), attached hereto.

II. COPIES (check at least one box)

- a. ☒ Submitted herewith is a legible copy of (i) each U.S. and foreign patent; (ii) each publication or that portion which caused it to be listed; and (iii) all other information or that portion which caused it to be listed.
- b. ☐ Some or all of the documents listed on the PTO-1449 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

III. CONCISE EXPLANATION OF THE RELEVANCE  
(check at least one box)

a. ☒ **DOCUMENTS IN THE ENGLISH LANGUAGE**

The attached patents, publications, or other information in the English language do not require a statement of relevancy.

b. ☒ **DOCUMENTS NOT IN THE ENGLISH LANGUAGE**

A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows:

English Abstracts are provided for each non-English reference listed on the attached PTO-1449 Form.

c. ☐ **ENGLISH LANGUAGE SEARCH REPORT**

An English language version of the search report or action that indicates the degree of relevance found by the foreign office is attached, thereby satisfying the requirement for a concise explanation. See MPEP 609(A)(3).

d. ☒ **OTHER**

The following additional information is provided for the Examiner's consideration.

AU 1413488 corresponds to EP 0 284 942; IE 913831 corresponds to EP 0484719; US 5,321,032 corresponds to WO 91/12266; IE 910819 corresponds to EP 0 446 706.

FEEs

IV. ☒ THIS IDS IS BEING FILED UNDER 37 C.F.R. § 1.97(b):  
(check one box)

- a. ☐ within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required. (This section is not to be used with RCE's and CPA's).
- b. ☐ within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.
- c. ☐ concurrently with the filing of a Continued Prosecution Application under 37 C.F.R. § 1.53(d) or concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.
- d. ☒ before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required.

In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p).

V. ☐ THIS IDS IS BEING FILED UNDER 37 C.F.R. § 1.97(c):  
(check one box)

before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

- a. ☐ No statement; therefore, a fee in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p).  
or
- b. ☐ See the statement below. No fee is required.

VI. STATEMENT UNDER 37 C.F.R. § 1.97(e) (check only one box)

The undersigned hereby states that

- a. ☐ each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or
- b. ☐ no item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.
- c. ☐ Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VII. PAYMENT OF FEES (check one box)

- ☐ A check in the amount of \$180.00 as required by 37 C.F.R. § 1.17(p) is enclosed for the above-identified fee.
- ☐ Please charge Deposit Account No. 02-2448 in the amount required by 37 C.F.R. § 1.17(p) for the above-indicated fee. A triplicate copy of this paper is attached.
- ☒ No fee is required.

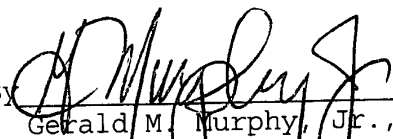
985  
Appl. No. 09/986,679

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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GMM/las  
2801-0165P

Enclosures:

- ☒ PTO-1449
- ☒ Documents
- ☐ Foreign Search Report
- ☐ Fee
- ☐ Other:

(Rev. 10/31/01)

Form PTO-1449  <b>INFORMATION DISCLOSURE CITATION IN AN APPLICATION</b> (Use several sheets if necessary)		ATTY DOCKET NO. 2801-0165P		APPLICATION NO. 09/286,679 985	
APPLICANT Russell M. HAGEN et al.		FILING DATE November 5, 2001		GROUP Unknown	

U.S. PATENT DOCUMENTS						
EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	5,321,032	1994-06-14	Matsuo et al.			
	5,538,982	1996-06-23	Hagan et al.			
	5,576,317	1996-11-19	Gonsalves			
	6,326,383 B1	2001-12-04	Hagan et al.			
	5,547,964	1996-08-20	Hagan et al.			
	5,360,820	1994-11-01	Hagan et al.			
	4,839,465	1989-06-13	Singh et al.			
	5,798,363	1998-08-25	Hagan et al.			
	5,102,667	1992-04-07	Dubroeucq et al.			
	4,066,772	1978-01-03	Vandenberk et al.			

FOREIGN PATENT DOCUMENTS						
	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION YES NO
	0 533 280 A1	1993-03-24	EPO			
	0 327 099 A1	1989-08-09	EPO			
	0 284 942 A2	1988-10-05	EPO			X
	2 216 529 A	1989-10-11	UK			
	WO 91/02745 A1	1991-03-07	PCT			
	0 484 719 A2	1992-05-13	EPO			X
	WO 91/18016 A1	1991-11-28	PCT			
	WO 91/12266 A1	1991-08-22	PCT			X
	0 482 539 A2	1992-04-29	EPO			
	0 446 706 A2	1991-09-18	EPO			X

OTHER DOCUMENTS	
(Include Name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	
	Niel, Arch. int. Physiol. Biochim. Biophys., 99, 5, A65-A76, 1991
	Leslie, Neurochem. Int., 7(2) 191-211, 1985
	Andrews et al., TIPS, 9, 334-341, 1988
	Carpenter et al., Cell and Mol. Neurobiol., 3(2) 113-126, 1983
EXAMINER _____ DATE CONSIDERED _____	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

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U.S. PATENT DOCUMENTS						
EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	4,031,226	1977-06-21	Soudijn et al.			

FOREIGN PATENT DOCUMENTS						
	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB CLASS	TRANSLATION YES      NO
	WO 92/17449 A1	1992-10-15	PCT			
	WO 93/01170 A1	1993-01-21	PCT			
	O 627 221 A2	1994-12-07	EPO			
	O 522 808 A2	1993-01-13	EPO			
	WO 93/00331 A1	1993-01-07	PCT			
	O 769 300 A2	1997-04-23	EPO			
	910819	1991-09-25	IE			
	913831	1992-05-06	IE			
	O 615 751	1994-09-21	EPO			
	14134/88 A	1988-10-06	AU			

OTHER DOCUMENTS	
(Include Name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published.	
	Carpenter et al., <i>Fed. Prod. Am. Sco. Exp. Biol.</i> , 43(15), 2952-2954, 1984
	Saffroy et al., <i>Peptides</i> , 9, 227-241, 1988
	Tattersall et al., <i>European Journal of Pharmacology</i> , 250, R5-R6, Nov. 1, 1993
	Bountra et al., <i>European Journal of Pharmacology</i> , 249, R3-R4, Nov. 1, 1993
EXAMINER _____ DATE CONSIDERED _____	
EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

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